

REMARKS

Favorable reconsideration of this application is requested in view of the following remarks. Claims 1-4 and 7-20 are amended and remain actively pending in the case. No new matter has been added. Reconsideration of the claims is respectfully requested.

In paragraph 5 on page 4 of the final Office Action, claims 1-4, 7-9 and 16-18 were rejected under 35 USC § 103(a) as being unpatentable over Kinjo (US 6,519,046) and Miyazaki et al. (US 6,619,166) in view of Matsumura et al. (US 5,949,431). In paragraph 6 on page 10 of the final Office Action, dependent claims 14 and 15 were rejected under 35 USC § 103(a) as being unpatentable over Kinjo, Matsumura and Miyazaki as applied to claim 1, and further in view of Fernandez et al. (US 2002/0092215). In paragraph 7 on page 12 of the final Office Action, claim 12 was rejected under 35 USC § 103(a) as being unpatentable over Kinjo, Matsumura and Miyazaki as applied to claims 1 and 9, and further in view of Buck (US 5,851,614). In paragraph 8 on page 12 of the final Office Action, claim 11 was rejected under 35 USC § 103(a) as being unpatentable over Kinjo, Matsumura and Miyazaki as applied to claims 1 and 9, and further in view of Peck (US 5,899,010). In paragraph 9 on page 13 of the final Office Action, claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Kinjo, Matsumura and Miyazaki as applied to claims 1 and 9, and further in view of Ogikubo (US 5,994,990). In paragraph 10 on page 14 of the final Office Action, claim 13 was rejected under 35 USC § 103(a) as being unpatentable over Kinjo, Matsumura and Miyazaki as applied to claim 1, and further in view of Poole (US 5,962,368). In paragraph 11 on page 15 of the final Office Action, claims 19 and 20 were rejected under 35 USC § 103(a) as being unpatentable over Kinjo and Miyazaki. Applicants respectfully traverse the rejections.

Kinjo fails to teach or suggest at least conducting cutting operations at predetermined locations on said sheet of media based on position location information of said selected subject on said sheet of media located in said selected subject image file as recited in claim 1. Rather, Kinjo traces an outline of a part 120 of a displayed image and stores the traced part 120 in memory 96. Col. 9, lines 8-18. However, as admitted by the Office and Advisory Action, Kinjo does not teach producing a cut image product from a sheet of media and also

Kinjo does not teach that position information is located in the digital image data itself. Kinjo does not use a selected subject image file in conducting cutting operations at predetermined locations on a sheet of media based on position location information of the selected subject on the sheet of media located in the selected subject image file.

Miyazaki fails to remedy the deficiencies of Kinjo as Miyazaki fails to teach or suggest at least conducting cutting operations at predetermined locations on said sheet of media based on position location information of said selected subject on said sheet of media located in said selected subject image file. Rather, Miyazaki merely discloses a printing apparatus in which a cutting pattern is selected from a plurality of predetermined cutting patterns. Col. 2, lines 19-20. In Miyazaki, predetermined layout and image shapes are made available to the user. In operation, the first step is the selection of an image illustrated by 10A in Figure 16. Then a layout and punching shape is selected. *See* Fig. 16, 10B and 10C; Col. 10, lines 62-65. Template images such as those set forth in Figures 20A, 20B and 20C are used in conjunction with images to produce composite images as set forth in Figures 21A, 21B and 21C respectively. These images are printed in a pattern in accordance with a selected layout. Col. 10, line 58 – Col. 12, line 23. Miyazaki does not use a selected subject image file in which cutting operations are conducted at predetermined locations on a sheet of media based on position location information of the selected subject on the sheet of media located in the selected subject image file.

Matsumura fails to remedy the deficiencies of Kinjo and Miyazaki as Matsumura fails to teach or suggest at least conducting cutting operations at predetermined locations on said sheet of media based on position location information of said selected subject on said sheet of media located in said selected subject image file. As Matsumura discloses, and the Advisory Action admits in the last paragraph of page 3, Matsumura discloses a table showing data relating to a cutout mask part CM and a target image part PP. The data represents the position and layout priority of the parts with respect to each other on a one-page image layout. Col. 6, lines 11-23; Col. 7, line 50 – Col. 8, line 6. However, the table disclosed by Matsumura is not a selected subject image file as recited in Applicants' claims and disclosed in Applicants' Specification (*see* at least Fig. 5) and is not used in conducting cutting operations at predetermined locations on a

sheet of media based on position location information of the selected subject on the sheet of media located in the selected subject image file.

Further, Applicants respectfully disagree the Advisory Action's assertion that "it would have been obvious to one of ordinary skill in the art to include position data in the digital image itself instead of storing a table with the position data." See Advisory Action, page 3 last paragraph. Applicants respectfully submit that the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Applicants respectfully request that the Examiner submit an affidavit as to the Examiner's personal knowledge or submit a prior art reference suggesting the desirability of modification.

Thus, in view of the above remarks, Applicants' invention is patentable over the cited references. It is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of Fernandez, Buck, Peck, Ogikubo, Poole as applied to the above prior art references is moot, inasmuch as the combination of Kinjo, Miyazaki, Matsumura, Fernandez, Buck, Peck, Ogikubo and Poole still lacks any teaching, disclosure, or suggestion concerning conducting cutting operations at predetermined locations on said sheet of media based on position location information of said selected subject on said sheet of media located in said selected subject image file as previously discussed.

In addition, Appellants respectfully contend that a *prima facie* case of obviousness has not been established, as described more fully below. To establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
 - 2) there must be a reasonable expectation of success; and
 - 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.
- (M.P.E.P. §2142).

Applicants respectfully submit that the cited references do not teach or suggest all the claim limitations as discussed above.

Further, there must be some actual *motivation* to combine the references found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest the combination. Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

For example, it is respectfully submitted that Matsumura fails to provide any suggestion to implement or otherwise be combined with image cutting apparatus as described in Miyazaki. Moreover, Miyazaki fails to provide any suggestion to implement or otherwise be combined with image layout apparatus for displaying a one-page image as described in Matsumura.

Thus, Applicants respectfully contend that a *prima facie* case of obviousness has not been established as no “clear and particular” evidence of motivation to combine can be identified. The Examiner must show some objective teaching leading to the combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). It is respectfully submitted that there is no such objective teaching in at least Matsumura that leads “to the combination” of Matsumura with Miyazaki, and the Examiner has pieced together aspects purportedly found in the prior art to arrive at the invention through hindsight. As stated by the Federal Circuit:

“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply **takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.**”

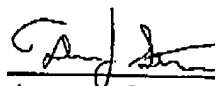
In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); emphasis added).

As such, there is no basis in the references themselves to motivate a person skilled in the art to combine at least the Matsumura reference with the Miyazaki reference.

Therefore, in view of the above remarks, Applicants' independent claim 1 is patentable over the cited references. Rejected independent claims 18-20 recite one or more features generally similar to those of claim 1 discussed above. Accordingly, for similar reasons as discussed above, independent claims 18-20 are believed to be patentable over the cited references. Because claims 2-4 and 7-17 depend from claim 1 and include the features recited in the independent claim, Applicants respectfully submit that claims 2-4 and 7-17 are also patentably distinct over the cited references. Nevertheless, Applicants are not conceding the correctness of the final Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.